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| EXAMINER |
|---|
| ABEL JALIL, NEVEEN |

| ART UNIT | PAPER NUMBER |
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| 2165 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/990,359 | MOSTAFA, MIRAJ |
| | Examiner | Art Unit |
| | Neveen Abel-Jalil | 2165 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on *November 22, 2006*.

2a) ☐ This action is **FINAL**.  2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) *1-16 and 19-22* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-16 and 19-22* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All  b)☐ Some * c)☐ None of:

        1. ☒ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____.

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1.      A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection.  Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114.  Applicant's submission filed on 22-November-2006 has been entered.

2.      The amendment filed on 22-November-2006 has been received and entered.  Claims 17

and 18 have been cancelled. Therefore, claims 1-16, and 19-22 are now pending.

3.      Amendments to the claims have overcome the previous claim objections.

### *Claim Objections*

4.      Claims 1, 11-13 are objected to because of the following informalities:

Claims 1, 11-13 recite "for transmission" which constitute intended use never have to

occur/happen. Claims should be amended to recite more firm and positive language (i.e. "to",

"is", "that"). Appropriate correction is required

Claims 11, and 12, both recite the abbreviation "MMS" which is improper. All acronyms

must be spelled out in their entirety when first introduced in the claims.

## *Claim Rejections - 35 USC § 112*

5.      The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6.      Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing

to particularly point out and distinctly claim the subject matter which applicant regards as the

invention.

Claim 6 appears to be directed to only one result of the determination (i.e. format is not

appropriate), while the other result (i.e. format is appropriate) is not mentioned at all. The claims

is indefinite for failing to show both instances of the determination since having only one

instance, begs the question to what happens if the other instance occurs? The claims should be

amended to recite "when the format is appropriate, providing the media content" or something to

that effect.

## *Claim Rejections - 35 USC § 102*

7.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8.      Claims 1-7, 9-16, and 19-22 are rejected under 35 U.S.C. 102(e) as being anticipated by

Luzeski et al. (U.S. Patent No. 6,430,177 B1).

As to claims 1, 11, 12, and 13, Luzeski et al. discloses a method in a network entity, a computer program for controlling a network entity stored therein, the program when executed causing the network to perform, a communication system, comprising:

at least one recipient (lines 28-34 of column 15 designates the message destined for multiple recipients and lines 54-55 of column 16);

a network entity (abstract);

receiving media content from a sending entity and addressed to at least one recipient (lines 28-34 of column 15 designates the message destined for multiple recipients and lines 54-55 of column 16);

accessing a database comprising recipient data describing at least one of multimedia reception capabilities and reception preferences for at least one recipient (Interpreted to be option between one or the other, see column 13, lines 18-33, also see column 14, lines 6-12);

forming, in accordance with said at least one of multimedia reception capabilities and reception preferences, a notification message (lines 7-29 of column 20) containing information that said media content is available to be streamed to said at least one addressed recipient (lines 49-54 of column 20, line 66 of column 20 through line 12 of column 21, and Fig. 4D); and

outputting the notification message (lines 49-54 of column 20, line 66 of column 20 through line 12 of column 21, and Fig. 4D) for transmission to said at least one addressed recipient (The recitation of "for" accomplishing a function is intended use, indirect, and passive which renders any recitation claimed after not be given patentable weight).

As to claim 2, <u>Luzeski et al.</u> discloses further comprising the steps of:

receiving the media content in a multimedia messaging server (abstract and lines 23-34 of

column 2); and

providing the at least one addressed recipient with the media content via the network

entity (lines 28-34 of column 15 designates the message destined for multiple recipients and lines

54-55 of column 16);

wherein the network entity is a multimedia messaging relay (lines 22-34 of column 2 and

lines 25-45 of column 4).


As to claim 3, <u>Luzeski et al.</u> discloses wherein a streaming session is established and at

least some of the media content is streamed to said at least one recipient (lines

30-48 of column 20, lines 55-65 of column 20, and Fig. 4D).


As to claim 4, <u>Luzeski et al.</u> discloses wherein said establishing of a streamed session is

preceded by transmitting the notification message to said at least one addressed recipient (lines

30-48 of column 20, lines 55-65 of column 20, and Fig. 4D, also lines 27-32 of column 12).


As to claim 5, <u>Luzeski et al.</u> discloses wherein the media content comprises a set of

different types of components and each component can be formatted in one or more formats (See

column 2, lines 4-34, prior art).

As to claim 6, <u>Luzeski et al.</u> discloses wherein the method further comprises the

following steps before said outputting of the media content:

checking the format of at least one component of the received media content (See column

2, lines 4-34, prior art);

determining by using the recipient data whether the format is appropriate for said at least

one addressed recipient (See column 4, lines 45-54, also see column 12, lines 5-15, also see

column 14, lines 41-65); and

responsive to determining that the format is not appropriate for the said at least one

addressed recipient, translating the component into a format appropriate for said at least one

addressed recipient (See column 4, lines 45-54, also see column 12, lines 5-15, also see column

14, lines 41-65).


As to claim 7, <u>Luzeski et al.</u> discloses wherein said notification message provides a

minimum amount of information necessary for said at least one addressed recipient to establish a

streaming session with the said network entity (See column 18, lines 15-42, also see column 17,

lines 1-18).


As to claim 9, <u>Luzeski et al.</u> discloses wherein said sending entity is **chosen from a**

**group** consisting of:

a media storing entity of a first telecommunication network, a media storing entity of a

second telecommunication network, a media storage in an external data transmission network,

and a terminal of the first telecommunication network (lines 51-54 of column 3, lines 29-45 of

column 5 and item 10-2 of Fig. 1 --notification server--, lines 46-62 of column 5 and items 12-4

and 12-5, both of Fig. 1 --content server--; items are shown as separate units --messaging

platform 10-- and --server (web platform) 12-- in Fig. 1).


As to claim 10, Luzeski et al. discloses wherein the sending entity is selected from the

group consisting from a media storing entity of a first telecommunications network and a

terminal of the first telecommunication network, wherein the first telecommunication network

possesses given properties, and wherein the method further comprises transmitting the

notification message to said at least one addressed recipient via a first telecommunication

network and forming said notification message taking into account the properties of the first

telecommunication network (lines 28-34 of column 15 designates the message destined for

multiple recipients and lines 54-55 of column 16).


As to claim 14, Luzeski et al. discloses wherein the media content comprises a set of

different types of components and each component can be formatted in one or more formats (See

column 2, lines 4-34, prior art, also see column 13, lines 18-25).


As to claim 15, Luzeski et al. discloses wherein the first telecommunication network

posses multimedia capabilities (See column 5, lines 46-55, also see column 6, lines 22-32) ,

traffic condition (inherit in the network part of reducing overhead column 3, lines 1-9), and

processing resources (See column 4, lines 46-50, wherein "processing resources" reads on

"viewable by custom clients"), and wherein said properties of the first telecommunications

network contain **at least one** or more of the following:

the first telecommunications network's multimedia capabilities (See column 18, lines 15-

42), the first telecommunication network's traffic condition, and the availability of processing

resources in the first telecommunication network (See column 13, lines 49-57).


As to claim 16, <u>Luzeski et al.</u> discloses wherein the receiving of the media content form a

sending entity includes forwarding the media content, via said network entity to a multimedia

messaging server corresponding to a communication system of said network entity (lines 22-34

of column 2 and lines 25-45 of column 4).


As to claims 19-22, <u>Luzeski et al.</u> discloses wherein the forming of the notification

message and the outputting of the notification message are performed locally within a

multimedia environment (The recitation of environment is broad enough to encompass many and

all things (server, client, or database) thus column 4, lines 40-50 of <u>Luzeski et al.</u> teaches

message portion header for presentation and body with content for targeted delivery all in one

message).


## *Claim Rejections - 35 USC § 103*

7.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
manner in which the invention was made.

8.      Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Luzeski et al.

(U.S. Patent No. 6,430,177 B1) in view of Ehrlich et al. (U.S. Patent No. 6,546,427 B1).


Luzeski et al. does not each wherein the network entity communicates with the at least

one addressed recipient over a radio communication network.

Ehrlich et al. teaches wherein the network entity communicates with the at least one

addressed recipient over a radio communication network (See Ehrlich et al. Figure 1, 12, radio

station, 16, Internet, wherein the user is accessing radio services through the Internet, also see

Ehrlich et al. column 3, lines 18-31).

It would have been obvious to one having ordinary skill in the art at the time the

invention was made to communication with at least one addressed recipient over a radio

communication network because it constitute one example of various modes of communication

networks currently avaible in the art and provides for better access to resources around the globe

(See Ehrlich et al. column 1, lines 52-57).


**Alternatively, the claims are rejected under:**

*Claim Rejections - 35 USC § 102*

9.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
subsection of an application filed in the United States only if the international application designated the United
States and was published under Article 21(2) of such treaty in the English language.

10.     Claims 1-16, and 19-22 are rejected under 35 U.S.C. 102(e) as being anticipated by

Makipaa et al. (U.S. Patent No. 6,556,217 B1).

As to claims 1, 11, 12, and 13, Makipaa et al. discloses a method in a network entity, a

computer program for controlling a network entity stored therein, the program when executed

causing the network to perform, a communication system, comprising:

at least one recipient (See Figure 1, 30, user terminal);

a network entity (See Figure 1, 20, content server, connected in a network);

receiving media content from a sending entity and addressed to at least one recipient (See

Figure 2, 10, shows content generators, 30, shows end user receiving such content);

accessing a database comprising recipient data describing at least one of multimedia

reception capabilities and  reception preferences for at least one recipient (See Figure 2, 20,

wherein a database and other modules are shown that store user profiles, and terminal

capabilities);

forming, in accordance with said at least one of multimedia reception capabilities and

reception preferences, a notification message containing information that said media content is

available to be streamed to said at least one addressed recipient (See column 5, lines 40-53, and

see column 6, lines 1-13); and

outputting the notification message for transmission to said at least one addressed

recipient (See column 5, lines 40-53).

As to claim 2, <u>Makipaa et al.</u> discloses further comprising the steps of:

receiving the media content in a multimedia messaging server (See column 5, lines 19-22); and

providing the at least one addressed recipient with the media content via the network entity (See column 6, lines 14-27);

wherein the network entity is a multimedia messaging relay (See column 5, lines 22-38, also see column 4, lines 43-45, wherein HTML-capable cellular phones are taught).

As to claim 3, <u>Makipaa et al.</u> discloses wherein a streaming session is established and at least some of the media content is streamed to said at least one recipient (See column 6, lines 10-21).

As to claim 4, <u>Makipaa et al.</u> discloses wherein said establishing of a streamed session is preceded by transmitting the notification message to said at least one addressed recipient (See column 5, lines 48-53).

As to claim 5, <u>Makipaa et al.</u> discloses wherein the media content comprises a set of different types of components and each component can be formatted in one or more formats (See column 5, lines 53-62).

As to claim 6, <u>Makipaa et al.</u> discloses wherein the method further comprises the following steps before said outputting of the media content:

checking the format of at least one component of the received media content (See column

5, lines 40-53);

determining by using the recipient data whether the format is appropriate for said at least

one addressed recipient (See column 5, lines 40-53); and

responsive to determining that the format is not appropriate for the said at least one

addressed recipient, translating the component into a format appropriate for said at least one

addressed recipient (See column 5, lines 53-62).


As to claim 7, Makipaa et al. discloses wherein said notification message provides a

minimum amount of information necessary for said at least one addressed recipient to establish a

streaming session with the said network entity (See column 5, lines 40-53).


As to clam 8, Makipaa et al. teaches wherein the network entity communicates with the at

least one addressed recipient over a radio communication network (See column 5, lines 35-38).


As to claim 9, Makipaa et al. discloses wherein said sending entity is **chosen from a**

**group** consisting of:

a media storing entity of a first telecommunication network, a media storing entity of a

second telecommunication network, a media storage in an external data transmission network,

and a terminal of the first telecommunication network (See Figure 1, shows different sources of

content providers).

As to claim 10, <u>Makipaa et al.</u> discloses wherein the sending entity is selected from the

**group consisting** from a media storing entity of a first telecommunications network and a

terminal of the first telecommunication network, wherein the first telecommunication network

possesses given properties, and wherein the method further comprises transmitting the

notification message to said at least one addressed recipient via a first telecommunication

network and forming said notification message taking into account the properties of the first

telecommunication network (See Figure 1, shows different sources of content providers).


As to claim 14, <u>Makipaa et al.</u> discloses wherein the media content comprises a set of

different types of components and each component is formatted in one or more formats.


As to claim 15, <u>Makipaa et al.</u> discloses wherein the first telecommunication network

posses multimedia capabilities, traffic condition, and processing resources, and wherein said

properties of the first telecommunications network (See column 5, lines 28-48) contain **at least**

**one** or more of the following:

the first telecommunications network's multimedia capabilities (See column 5, lines 28-

48), the first telecommunication network's traffic condition, and the availability of processing

resources in the first telecommunication network.


As to claim 16, <u>Makipaa et al.</u> discloses wherein the receiving of the media content form

a sending entity includes forwarding the media content, via said network entity to a multimedia

messaging server corresponding to a communication system of said network entity (See column

5, lines 28-48).


As to claims 19-22, <u>Makipaa et al.</u> discloses wherein the forming of the notification

message and the outputting of the notification message are performed locally within a

multimedia messaging service environment (See Figure 2, shows "multimedia messaging

environment").


### *Response to Arguments*

11.    Applicant's arguments filed on November 22, 2006 have been fully considered but they

are not persuasive.


In response to applicant's argument that "Applicant's notes that all of the individual

processes are to occur within a single network entity and are not distributed among multiple

entities" is acknowledged but not deemed to be persuasive.

There's no mention of "network entity" at all in the body of the Independent claims.

Furthermore, there's no specific or narrow definition given in the claims to indicate that all the

claimed steps are being preformed with in a single network entity unit and not in distributed

network. The only reference of a "Network entity" in the Independent claims is made in the

preamble which carries no patentable weight. In fact, the body of the claim appears to suggest

the system to be distributed since the first limitation is directed to "sending entity" which can

only indicate the it is a separate unit.

More so, claim 12, lists the "network entity" as separate unit/segment of the many

units/segments in an over-all system without any further suggestions that the remaining elements

are part of that specific unit. Instead they too appear as separate units in the system not unlike the

system of Luzeski.

Furthermore, the wording of the preamble of independent claim 13 states "for controlling

a network entity" which in itself is intended use and appears to suggest remote access or control

of said "network entity".

There's no clear definition in Applicant's disclosure as to the specific meaning of

Network entity, the only reference to both the database and the network entity can be found in

Applicant's disclosure paragraph [0056] Preferably, said database is co-located with the network

entity. Even more preferably, said database and network entity are integrated into the same unit.

There's no mention of the processor or input/output also being part of said one unit.

Thus, the claims are broadly interpreted to still read on the cited reference.


In response to applicant's argument that "Luzeski et ál. does not describe reception

preferences and/or capabilities" is acknowledged but not deemed to be persuasive.

User/reception preference are inertly part of a profile which is taught in Luzeski column

23, lines 21-30:

> MPS provisions MHS Addressing Services 10-1 with the subscriber data from UVMS. MHS Addressing
> Services returns subscriber data specific to e-mail communications and Web browser access, such as
> profile name, password, SMTP address, and X.400 address.

Luzeski also teaches customized messaging client with suitable capabilities (i.e. support for

download/streaming) is required to run his invention as stated in column 18, lines 2-14:

> Standard messaging clients (e.g., such as Microsoft Exchange and Lotus Notes cc:Mail) are only capable of acting on messages where the message type field is IPM:xxxx, where "xxxx" could be Note, NDN, Report, etc. The multimedia container concept disclosed herein relies on a messaging client that has the capability to recognize message types other than IPM. In the case of the Universal Messaging system, the message type used for multimedia containers is "BLT:UMSCONTENT.&lt;content_type&gt;" (where BLT stands for bilateral defined type). A custom messaging client for multimedia containers must have the capability to both create and interpret CMC messages of type BLT:UMSCONTENT.

Luzeski teaches his platform to provide translation of various content prior to rendering as show

in column 4, lines 2-4:

> The CMC layer provides an industry standard mechanism for providing a standard API through which access to proprietary message stores can be made.

Thus, broadly interpreted to read on the argued limitation.

The Ehrlich reference was introduced to teach radio communication as explained in the

rejection above.

### *Conclusion*

12.    The prior art made of record and not relied upon is considered pertinent to applicant's
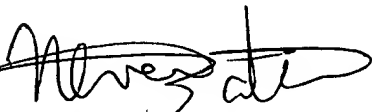
disclosure.

Caj Södergård et al., "Integrated multimedia publishing - combining TV and newspaper

content on personal channels", The 8Th. International WWW conference, pp. 33-50, May 11-14,

1999.

13.    Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074.

The examiner can normally be reached on 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neveen Abel-Jalil
January 23, 2007